

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to the specification because the “central axis O1 of the sheath 4” at page 21, line 14 is incorrect and should be --central axis O of the sheath 4--. In response, the specification has been amended as suggested by the Examiner. Accordingly, it is respectfully requested that the objection to the specification be withdrawn.

In the Official Action, the Examiner objects to claim 10 because the recitation of "the rocking axis being formed integrally with the flat portion" is unclear. In response, claim 10 has been amended to clarify the same. Accordingly, it is respectfully requested that the objection to claim 10 be withdrawn.

In the Official Action, the Examiner rejects claims 1, 6 and 7 under 35 U.S.C. § 102(a) as being anticipated by JP 02000279418A to Suzuki (hereinafter “Suzuki”). Furthermore, the Examiner rejects claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of U.S. Patent No. 4,715,809 to Langhoff et al., (hereinafter “Langhoff”).

In response, Applicants respectfully traverse the Examiner’s rejections under 35 U.S.C. §§ 102(a) and 103(a) for at least the reasons set forth below. However, independent claim 1 has been amended to clarify its distinguishing features. Specifically, independent claim 1 has been amended to recite:

“a swingable operating section formed of a pair of forceps, each of which rocks individually around a respective first rocking axis corresponding thereto;

a tubular sheath having a distal end portion situated on a proximal end side of the operating section, the distal end portion having a circular-section portion having a circular cross section perpendicular to a longitudinal central axis of the tubular sheath and a pair of parallel flat portions symmetrically formed on

opposite sides of the circular-section portion and in sliding contact with respective proximal end portions of the forceps;

a pair of manipulators which advance and retreat along the longitudinal central axis of the tubular sheath, thereby rocking the forceps around the first rocking axis; and

a pair of junctions which respectively connect the manipulators for rocking motion around a second rocking axis to the forceps in the flat portions, the junctions being situated substantially on a reference plane containing the longitudinal axis of the tubular sheath and extending parallel to the second rocking axis, when the operating section is closed.”

The amendment to claim 1 is fully supported in the original disclosure. Thus, no new matter has been introduced into the disclosure by way of the present amendment to independent claim 1. Further, the amendment to claim 1 is at least directed to the species elected in the response filed on March 19, 2007 (e.g., Species I, Figures 3A-4D) or generic thereto.

In contrast to amended claim 1, Suzuki simply does not disclose or suggest locating the junctions formed between the forceps and the operating wires on a reference plane passing through a central longitudinal axis of the tubular sheath and parallel to the rocking axes. In fact, the structure of the arrangement disclosed in Suzuki is clearly different from that recited in independent claim 1.

With regard to the rejection of claims 1, 6 and 7 under 35 U.S.C. § 102(a), a medical instrument having the features discussed above and as recited in independent claim 1 is nowhere disclosed in Suzuki. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claim 1 is not anticipated by Suzuki. Accordingly, independent claim 1 patentably distinguishes over Suzuki and are allowable.

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

Claims 6 and 7 being dependent upon claim 1 are thus at least allowable therewith.

Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 6 and 7 under 35 U.S.C. § 102(a).

With regard to independent claim 10 and Langhoff, the same describes an invention related to a heat exchanger. Cooling tube (1) in Langhoff is not a rocking axis but a device similar to a cooling fin. Since the medical instrument of claim 10 and Langhoff are so different in their categories, those of ordinary skill in the art at the time of the invention would not have looked to Langhoff to combine the features thereof with the medical device of Suzuki.

Claim 10 recites a medical instrument used with an endoscope, in which the medical instrument is very small. Therefore it is so important and difficult to decrease projections of a few millimeters or the number of members that it cannot be compared with the one in the category disclosed in Langhoff. Thus, those of skill in the art would not be motivated or suggested to combine the medical device of Suzuki with the heat exchanger of Langhoff. Furthermore, the medical instrument of claim 10 is not a predictable variation of the device of Suzuki.

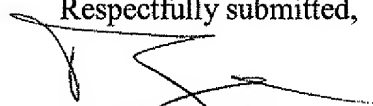
Still further, Langhoff is neither in the same field of endeavor as the medical device of claim 10 nor is it directed to the same objective as the medical device of claim 10, therefore, Applicants respectfully submit that Langhoff is from a non-analogous art.

For at least these reasons, Applicants submit that Langhoff is an improper reference and must be withdrawn. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 10 under 35 U.S.C. § 103(a).

Furthermore, new claims 16-21 have been added to further define the patentable invention. New claims 16-21 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 16-21. Applicants respectfully submit that new claims 16-21 are at least allowable as depending upon an allowable base claim (1). Applicants further submit that new claims 16-21 are at least directed to the species elected in the response filed on March 19, 2007 (e.g., Species I, Figures 3A-4D) or generic thereto.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser PC
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm